Remarks

The foregoing amendment is hereby submitted for the Examiner's consideration to comply with the objections or requirement of form expressly set forth in the Office Action, and to better place the present application in condition for allowance, in accordance with 37 C.F.R. § 1.116(a).

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 47-63 are pending in the application, with claims 47, 53, and 56 being the independent claims. Claims 47, 49, 51-53, 55-57, and 60-62 are sought to be amended. Support for these changes can be found, for example, in the issued parent patent (U.S. 6,264,891) at col. 8, line 8 to col. 9, line 21; Fig. 4; col. 10, lines 7-25; col. 14, line 24-col. 15, line 12; and claim 47. These changes are believe to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 112, second paragraph

Claims 47-63 are rejected as allegedly being indefinite under 35 U.S.C. § 112, second paragraph. Office Action, page 2.

The Office Action states that throughout the claims, "for synthesizing a polymer" in the preamble is indefinite because it is unclear what structural limitations this term

intends. Claims 47, 53 and 56 as amended do not recite "for synthesizing a polymer" in the preamble.

The Office Action also states that the recitation of "the base" in claim 49 lacks antecedent basis. Claim 47 as amended now provides antecedent basis for "the base" in claim 49.

The Office Action also states that claims 51, 55 and 56 are indefinite because it is unclear what limitation was intended, and what structural limitation is intended by, "performs a physical step." Claims 51, 55 and 56 no longer recite the language characterized as indefinite. Instead, these claims now recite stations which perform specific physical steps (e.g., fluid delivery, fluid incubation, fluid drainage, temperature control, and optical analysis).

The Office Action also states that claims 52 and 57 are indefinite since it is unclear whether or not the reagents are positively recited. Claim 52 depends (indirectly) from claim 47 which recites at least one of a plurality of reagents. Thus, claim 52 is definite with regard to positive recitation of reagents. Claim 57 as amended recites said at least one of a plurality of reagents, thus it is clear that the reagents are positively recited.

Therefore, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, and allowance of the above claims.

Rejection under 35 U.S.C. § 102(b)

Claims 47-49, 51-52, 56-57 and 60-62 are rejected under 35 U.S.C. § 102(b), as allegedly being anticipated by U.S. Patent No. 4,871,683 to Harris *et al.* (herein referred

to as "Harris"). Under 35 U.S.C. § 102, a claim can only be anticipated if every element in the claim is expressly or inherently disclosed in a single prior art reference. *See Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 711 (Fed. Cir. 1983), *cert. denied*, 465 U.S. 1026 (1984).

Independent claims 47 and 56 as amended recite ***a drain system comprising a plurality of drain lines, whereby the liquids are drained through the drain lines by differential pressure***. Harris does not recite a "plurality of drain lines" (see fluid receiving chamber **112** and conduit **114** in Fig. 4 of Harris). In addition, Harris teaches a system for performing clinical assays, not "synthesizing a polymer", as presently claimed. More specifically, independent claims 47 and 56 recite that "each reaction mount is adapted to receive at least one of a plurality of reagents for synthesizing a polymer", a feature not disclosed by Harris.

Furthermore, regarding claims 47 and 56, the "turntable 12" described in Harris does not include "liquid conduits" as recited in Applicants' claims.

Since Harris does not disclose the claimed features discussed above, this reference does not anticipate claims 47-49, 51-52, 56-57 and 60-62. Thus, reconsideration and withdrawal of the rejection under 35 U.S.C. 102(b), and allowance of the above claims are respectfully requested.

Rejection under 35 U.S.C. §103(a)

Claims 50, 53-55, 58, 59 and 63 are rejected as allegedly being obvious over Harris and in view of Raysberg et al. (U.S. 5,106,583). Establishing *prima facie* obviousness requires a showing that each claim element is taught or suggested by the

prior art. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Specifically, establishing *prima facie* obviousness requires a showing that some combination of objective teachings in the art and/or knowledge available to one of skill in the art would have lead that individual to arrive at the claimed invention. *See In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Moreover, establishing *prima facie* obviousness requires not only a showing that such a combination of prior art teachings is possible, but also that the teachings would have 1) motivated the skilled artisan to make the combination to arrive at the claimed invention, and 2) suggested to the skilled artisan a reasonable likelihood of success in making and using the claimed invention. *See In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed. Cir. 1988). Absent a showing of such motivation and suggestion, *prima facie* obviousness is not established. *See Fine*, 5 USPQ2d at1598.

Neither Harris nor Raysberg teaches "a plurality of reagents for synthesizing a polymer" as recited in the present claims. Harris describes a system and method for performing a clinical assay (Col. 3, lines 10-16), and Raysberg describes a protein analysis apparatus that hydrolyzes a protein and then derivatizes the resultant amino acid (Col. 4, lines 6-9; and Col. 9, lines 31-38). Furthermore, regarding claims 47 and 56, the "turntable 12" described in Harris and the "rotating turret 19" described in Raysberg do not include "liquid conduits" as recited in Applicants' claims. Additionally, regarding claim 53, neither Harris nor Raysberg describe an "engagement port positioned under [a] carousel" that is capable of being "raised or lowered to engage or disengage with...exit ports" of the carousel "to drain liquid from the engaged exit port," as recited in Applicants' claims. Because the claim elements discussed above are not disclosed by

either of these references, the pending claims cannot be rendered obvious by the combination.

Accordingly, for the reasons stated above, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a), and allowance of the above claims.

Rejections for Non-Statutory Double Patenting

In the Office Action, the Examiner rejects claims 47, 48, 50-52, and 56-61 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-15 of U.S. Patent No. 6,264,891. To the extent this rejection is applicable to the pending claims as amended, Applicants respectfully request the Examiner's rejection to be held in abeyance until subject matter is indicated as being allowable without regard to this rejection.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite

prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Kendrick P. Patterson
Attorney for Applicants
Registration No. 45,321

Date: November 24, 2004

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

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